

## REMARKS

### STATUS OF THE CLAIMS

The Office Action dated March 4, 2004 has been received and its contents carefully considered. Claims 1 and 5-17 are pending. Claims 1 and 5-17 have been rejected. Claims 1, 5, 13, 15 and 17 have been amended. New claim 21 has been added.

Reconsideration and withdrawal of the outstanding rejections is respectfully requested in view of the following remarks.

### REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 12 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Seashore, et al.* (U.S. Patent No. 5,916,286) in view of *McMahon* (U.S. Patent No. 5,965,658). Without conceding the propriety of the rejection, independent claims 1 and 17 have been amended. It is respectfully submitted that *Seashore, et al.* does not teach, *inter alia*, a diagnostic tool comprising “a graphical user interface...wherein said output data is displayed on said graphical user interface” in combination with the rest of the claimed features as recited in claim 1 and similarly in claim 17. It is also respectfully submitted that *Seashore, et al.* does not teach, *inter alia*, a method of displaying diagnostic data comprising “displaying a list of diagnostic values on a graphical user interface of a hand held diagnostic tool” in combination with the additionally claimed features as recited in claim 12.

*Seashore, et al.* discloses a portable automotive diagnostic tool for receiving information from an automotive computer of a vehicle. Information stored by an automotive computer is downloaded by the portable automobile diagnostic tool and stored in the SRAM. This information may be accessed by a user and displayed on the LCD to determine the automobile

status (see *Seashore, et al.* column 3, lines 13-17). However, the automotive diagnostic tool disclosed by *Seashore, et al.* fails to teach a graphical user interface as recited in claims 1, 12 and 17 of the present invention. The diagnostic tool of the present invention utilizes a graphical user interface to display valves and/or graphs as shown, for instance in FIGS. 2-5 of the present application. *Seashore, et al.* lacks the capability to display graphs as such. *McMahon* fails to cure the deficiencies of *Seashore, et al.*, because it, too, fails to teach a graphical capability of the diagnostic tool as recited in claims 1, 12 and 17 of the present invention.

In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Therefore, since the prior art lacks all the claimed features, *Seashore, et al.*, alone, or in combination with *McMahon*, cannot be said to teach or suggest the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 5-7, 10 and 13-15 were rejected under 35 U.S.C. §103(a) as being obvious over *Seashore, et al.* in view of *McMahon* and further in view of *Borsuk* (U.S. Patent No. 5,475,399). Claims 5-7 and 10 depend ultimately from independent claim 1. Claims 13-15 depend ultimately from independent claim 12. *Seashore* in view of *McMahon* fail to teach the invention as recited in independent claims 1 and 12 of the present invention as outlined above. *Borsuk* does not cure the deficiencies of *Seashore* in view of *McMahon*, because it, too, fails to teach a graphical user interface as recited in claims 1 and 12 of the present invention. Therefore, since the prior art lacks all the claimed features, *Seashore*, alone or in combination with *McMahon* and in further

view of *Borsuk*, cannot be said to teach or suggest the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 8 and 9 were rejected under 35 U.S.C. §103(a) as being obvious over *Seashore* in view of *McMahon* and further in view of *Borsuk* and in further in view of *Danielson, et al.* (U.S. Patent No. 5,895,906). Claims 8 and 9 depend ultimately from independent claim 1. *Seashore* in view of *McMahon* fail to teach the invention as recited in claim 1 as outlined above. *Borsuk* does not cure the deficiencies of *Seashore/McMahon*, because it, too, fails to teach a graphical user interface as recited in claim 1 as outlined above. Likewise, *Danielson, et al.* fails to cure the deficiencies of *Seashore* in view of *McMahon* and further in view of *Borsuk*, because it, too, also fails to teach a graphical user interface linked to a microprocessor... wherein said output data is displayed on said graphical user interface as a list... and/or a graph of said output data as recited in claim 1. Therefore, since the prior art lacks all the claimed features, *Seashore*, alone or in combination with *McMahon*, *Borsuk* and/or *Danielson, et al.*, cannot be said to teach or suggest the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claim 11 was rejected under 35 U.S.C. §103(a) as being obvious over *Seashore* in view of *McMahon* in view of *Borsuk* and further in view of *Herrod, et al.* (U.S. Patent No. 6,405,049). Claim 11 depends ultimately from independent claim 1. *Seashore* in view of *McMahon* and *Borsuk* fail to teach the invention as recited in claim 1 as outlined above. *Herrod, et al.* does not cure the deficiencies of *Seashore* in view of *McMahon* and *Borsuk* because it, too, fails to teach a graphical user interface... wherein said output data is displayed on said graphical user interface as a list... and/or a graph as recited in claim 1 of the present invention. Therefore, since the prior art lacks all the claimed features, *Seashore*, alone or in combination with *McMahon/Borsuk/*

*Herrod, et al.*, cannot be said to teach or suggest the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claim 16 was rejected under 35 U.S.C. §103(a) as being obvious over *Seashore* in view of *McMahon* in further view of *Borsuk* and in further view of *Gurne, et al.* Claim 16 depends from claim 15 which requires, *inter alia*, storing a third diagnostic value into a memory device and displaying the third diagnostic value graphically over at least an axis. Claim 16 requires, *inter alia*, expanding at least one axis over a portion of the graphical display. The Examiner concedes that *Seashore/McMahon/Borsuk* do not teach “displaying a diagnostic value using a graph with an axis, nor changing the scale of the axis.” FIG. 12 of *Gurne, et al.* merely depicts captured data displayed graphically. However, the teachings of *Gurne, et al.* are limited in scope as they pertain to the present invention, because it fails to teach storing and displaying a third diagnostic value graphically over at least an axis (as required by claim 15 of the present invention) or expanding at least one axis over a portion of the graphical display (as required by claim 16 of the present invention). Therefore, since the prior art lacks all the claimed features, *Seashore*, alone, or in combination with *McMahon/Borsuk/Gurne, et al.*, cannot be said to teach or suggest the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claim 21 was added and depends ultimately from independent claim 1 and is patentable over the cited prior art for at least the same reasons as is claim 1.

#### REQUEST FOR WITHDRAWAL OF FINALITY

Withdrawal of finality of the Office Action dated March, 4, 2004 is requested. The Examiner stated that “Applicant’s amendment necessitated the new grounds of rejection”,

however, upon further inspection of the amended claims, it is believed that no new grounds were set forth. In the amendment filed January 20, 2004, claims 1, 12 and 13-17 were amended. Claims 2-4 and 18-20 were cancelled. The claimed subject matter of cancelled claims 2-4 was incorporated into amended claim 1. The claimed subject matter of claims 18-20 was incorporated into amended claim 17. No new matter was added, and furthermore, no new issues for consideration were raised by the amendment. Hence, withdrawal of finality is respectfully requested.

#### CONCLUSION

Any additional extension of time necessary to prevent abandonment is hereby requested, and any fee necessary for consideration of this response is hereby authorized to be charged to Deposit Account Number 50-2036.

In view of the foregoing, reconsideration and allowance of the application are believed in order, and such action is earnestly solicited.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned attorney at 202/861-1538.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read 'Marc W. Butler', with a large, stylized flourish at the end.

Marc W. Butler  
Registration No. 50,219

Date: September 7, 2004  
Washington Square, Suite 1100  
1050 Connecticut Avenue, N.W.  
Washington, D.C. 20036  
Tel. 202 861 1500  
Fax. 202 861 1783